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TOWNSEND AND TOWNSEND AND  
CREW  
ATTN: JOSEPH LIEBESCHUETZ  
379 LYTTON AVENUE  
PALO ALTO CA 94301-1431

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APR 09 2008

**OFFICE OF PETITIONS**

In re Application of :  
Weiner et al. : DECISION ON APPLICATION  
Application No. 09/618,380 : FOR  
Filed: July 18, 2000 : PATENT TERM ADJUSTMENT  
Atty Docket No. 11823-004920US:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705" filed October 1, 2007. Applicants submit that the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is nine hundred thirty-five (935) days, which applicants maintain is the difference between the total period of PTO examination delay (1,088 days) and the period of applicant delay (153 days).

The application for patent term adjustment is **DISMISSED**.

For the reasons stated herein, the Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days, including **84 days** of Office delay and **244 days** of applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 3, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. The instant application for patent term

adjustment was timely filed<sup>1</sup> after the mailing of the notice of allowance and no later than the payment of the issue fee.

Applicants maintain that the discrepancy between the PTO's determination and applicants' can be traced to a single item related to the alleged abandonment of the application between July 23, 2004 and April 23, 2007, for which no period of PTO delay was assigned. Applicants submit that the delay between July 23, 2004 and April 23, 2007 was due to the PTO's failure to match the issue fee with the file, and subsequent inexplicable further delay in rescinding the holding of abandonment notwithstanding verification of the issue fee payment by February 22, 2005 and applicants' unanswered status requests. Applicants assert that an additional period of adjustment of 1,004 days should be entered for this delay.

Applicants acknowledge that this application is currently subject to a terminal disclaimer.

Applicants' arguments have been considered, but not found persuasive. The grounds for entry of periods of adjustment for examination delay are set forth in 37 CFR 1.702. Those grounds do not include failure to take action within specified time frames in response to the filing of a petition to withdraw the holding of abandonment.

However, with respect to action taken in response to the payment of the issue fee, the relevant section to consider Office delay is 1.702(a)(4). 37 CFR § 1.702(a)(4) provides that:

subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv) and § 1.702(a)(4). Section 1.703(a)(6) specifies that:

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<sup>1</sup> PALM records indicate that the issue fee was paid on October 1, 2007.

the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued.

Nonetheless, as stated in the final rule:

the date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

In this instance, after the payment of the issue fee (and the granting of the petition), on May 4, 2007, applicants reopened prosecution with the filing of a request for continued examination. Thus, the filing of the issue fee payment on July 23, 2004 is not controlling. A new Notice of Allowance was mailed on July 3, 2007, and the Issue Fee transmittal was again submitted on October 1, 2007.

It is further noted that, with respect to the initial determination of patent term adjustment, the record further reveals that pursuant to 37 CFR 1.704(c)(10), periods of reduction of 113 (not 83) days and 61 days for the filing of two separate requests for continued examination (RCEs) after the mailing of a notice of allowance.

After the mailing of a Notice of Allowance on March 19, 2003 and payment of the issue fee on April 14, 2003, on September 10, 2003, applicants filed a RCE and amendment (and petition to withdraw from issue). The filing of the RCE and amendment after the mailing of the Notice of Allowance constituted a failure to engage pursuant to 37 CFR 1.704(c)(10). This period is 113 days, counting the number of days in the period beginning on September 10, 2003, the date of filing of the RCE and amendment and ending on December 31, 2003, the date of mailing of the Ex Parte Quayle in response.

Likewise, after the mailing of another Notice of Allowance on April 23, 2004 and payment of the issue fee on July 23, 2004, on May 4, 2007, applicants filed a RCE and Information Disclosure Statement (IDS) and amendment and application data sheet and sequence listing (and petition to withdraw from issue). The IDS did not include a § 1.704(d) statement. The filing of the RCE and other papers after the mailing of the Notice of Allowance constituted a failure to engage pursuant to 37 CFR 1.704(c)(10). This period is 61 days, counting the number of days in the period beginning on May 4, 2007, the date of filing of the RCE and other papers and ending on July 3, 2007, the date of mailing of the Notice of Allowance in response.

It is noted that the petition to withdraw holding of abandonment filed February 22, 2005 was filed within 2 months of the mailing of the notice of abandonment on January 20, 2005. As such, there was no "failure to engage" (or applicant delay) within the meaning of 37 CFR 1.704(c)(4).

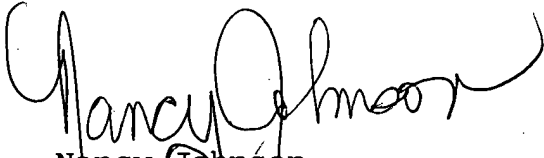
The record is unclear as to whether there should be entered additional periods of reduction for applicant delay associated with omissions in applicants' filing with respect to sequence listings. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq. If it is of significance, applicants are under a duty of candor to the Office to advise if in fact such replies with omissions were filed. (It is noted that without regard to any failures to engage pursuant to 37 CFR 1.704(c)(7) this application is likely to issue with a revised patent term adjustment of zero (0) days).

It is concluded that the correct patent term adjustment at the time of the mailing of the notice of allowance mailed July 3, 2007 is zero (0) days, including 84 days of Office delay and 244 days of applicant delay.

Applicants' submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded and to the extent that the period is not consumed by the filing of a request for continued examination).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

## PTA Calculations for Application: 09/618380

Application Filing Date:	07/18/2000	PTO Delay (PTO):	84
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	153
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-174		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
134	04/07/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		113	
133	04/07/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		61	
124	07/03/2007	MAIL NOTICE OF ALLOWANCE			
123	07/03/2007	MAIL EXAMINER'S AMENDMENT			
122	06/28/2007	ISSUE REVISION COMPLETED			
121	06/28/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
120	06/28/2007	DOCUMENT VERIFICATION			
119	06/28/2007	EXAMINER'S AMENDMENT COMMUNICATION			
118	06/28/2007	NOTICE OF ALLOWABILITY			
117	05/04/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
116	05/10/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
115	06/14/2007	CASE DOCKETED TO EXAMINER IN GAU			
114	07/18/2000	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
113	07/18/2000	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
112	05/24/2007	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
111	05/23/2007	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
110	05/18/2007	DATE FORWARDED TO EXAMINER			
109	05/04/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
108	05/18/2007	DATE FORWARDED TO EXAMINER			
107	05/04/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			

106	05/18/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
105	05/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
103	05/10/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
102	05/04/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
101	05/14/2007	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE - WITH ASSIGNED PATENT NO.			
100	05/14/2007	WITHDRAWAL PATENT CASE FROM ISSUE			
99	05/04/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
98	05/04/2007	PETITION ENTERED			
97	05/09/2007	ISSUE NOTIFICATION MAILED			
96	05/09/2007	WORKFLOW - REQUEST FOR RCE - FINISH			
95	05/29/2007	PATENT ISSUE DATE USED IN PTA CALCULATION			
94	05/04/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
93	05/02/2007	RECEIPT INTO PUBS			
92	05/02/2007	DISPATCH TO FDC			
91	02/22/2005	ISSUE FEE PAYMENT VERIFIED			
90	05/01/2007	DISPATCH TO FDC			
89	01/16/2007	MISCELLANEOUS INCOMING LETTER			
88	04/23/2007	APPLICATION IS CONSIDERED READY FOR ISSUE			
87	04/23/2007	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
86	02/22/2005	ISSUE FEE PAYMENT VERIFIED			
85	04/23/2007	WITHDRAW PUBLICATION/PRE-EXAM ABANDON			
84	02/22/2005	PETITION ENTERED			
83	09/30/2005	MISCELLANEOUS INCOMING LETTER			
82	03/03/2005	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
81	02/22/2005	ISSUE FEE PAYMENT RECEIVED			
80	04/14/2003	REVERSE ISSUE FEE			
79	01/20/2005	MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			
78	01/20/2005	ABANDONMENT FOR FAILURE TO PAY ISSUE FEE			

77	12/22/2004	MAIL-RECORD PETITION DECISION OF GRANTED RELATED TO ATTORNEY			
76	06/02/2004	PETITION ENTERED			
75	12/14/2004	CORRESPONDENCE ADDRESS CHANGE			
74	12/15/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
73	12/10/2004	RECEIPT INTO PUBS			
72	07/26/2004	WORKFLOW INCOMING PETITION IFW			
71	08/03/2004	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
70	07/29/2004	RECEIPT INTO PUBS			
69	07/26/2004	WORKFLOW INCOMING PETITION IFW			
68	06/11/2004	RECEIPT INTO PUBS			
67	06/02/2004	SEQUENCE FORWARDED TO PUBS ON TAPE			
66	05/27/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
65	05/26/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
64	04/23/2004	MAIL NOTICE OF ALLOWANCE			
63	04/22/2004	ISSUE REVISION COMPLETED			
62	04/22/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
61	04/22/2004	CASE DOCKETED TO EXAMINER IN GAU			
60	04/22/2004	NOTICE OF ALLOWABILITY			
59	02/25/2004	NEW OR ADDITIONAL DRAWING FILED			
58	02/25/2004	MISCELLANEOUS INCOMING LETTER			
57	03/10/2004	DATE FORWARDED TO EXAMINER			
56	02/25/2004	RESPONSE AFTER EX PARTE QUAYLE ACTION			
55	12/31/2003	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)			
54	12/30/2003	EX PARTE QUAYLE ACTION			
53	11/05/2003	DATE FORWARDED TO EXAMINER			
52	09/10/2003	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
51	11/05/2003	DATE FORWARDED TO EXAMINER			
50	09/10/2003	REQUEST FOR CONTINUED EXAMINATION (RCE)		83	40
49	11/05/2003	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
48	09/23/2003	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
47	09/22/2003	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			



46	09/10/2003	PETITION ENTERED			
45	09/10/2003	WORKFLOW - REQUEST FOR RCE - BEGIN			
44	06/09/2003	RECEIPT INTO PUBS			
43	06/05/2003	DISPATCH TO PUBLICATIONS			
42	06/04/2003	DISPATCH TO PUBLICATIONS			
41	04/14/2003	ISSUE FEE PAYMENT RECEIVED			
40	03/19/2003	MAIL NOTICE OF ALLOWANCE			
39	03/18/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
38	03/18/2003	NOTICE OF ALLOWABILITY			
37.7	12/04/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	12/04/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	01/16/2003	DATE FORWARDED TO EXAMINER			
35	12/04/2002	REQUEST FOR CONTINUED EXAMINATION (RCE)			
34	01/16/2003	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
33	01/03/2003	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
32	12/04/2002	WORKFLOW - REQUEST FOR RCE - FINISH			
31	12/04/2002	WORKFLOW - REQUEST FOR RCE - BEGIN			
30	10/21/2002	RECEIPT INTO PUBS			
29	09/16/2002	WORKFLOW - FILE SENT TO CONTRACTOR			
28	09/16/2002	RECEIPT INTO PUBS			
27	09/15/2002	DISPATCH TO PUBLICATIONS			
26	09/04/2002	MAIL NOTICE OF ALLOWANCE			
25	09/04/2002	MAIL NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED			
24	09/03/2002	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
23	09/03/2002	NOTICE OF ALLOWABILITY			
22	07/01/2002	NOTIFICATION OF TERMINAL DISCLAIMER - ACCEPTED			
21	05/20/2002	TERMINAL DISCLAIMER FILED		0	19
20	06/27/2002	DATE FORWARDED TO EXAMINER			
19	05/20/2002	RESPONSE AFTER NON-FINAL ACTION		70	17
18	05/20/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			

17	12/11/2001	MAIL NON-FINAL REJECTION	84		-1
16	12/10/2001	NON-FINAL REJECTION			
15	11/16/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
14	11/03/2001	DATE FORWARDED TO EXAMINER			
13	10/19/2001	RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES			
12	10/06/2001	CASE DOCKETED TO EXAMINER IN GAU			
11	09/28/2001	MAIL NON-BONAFIDE RESPONSE TO SEQUENCE REQUEST			
10	09/27/2001	NON-BONAFIDE RESPONSE TO SEQUENCE REQUEST			
9	08/08/2001	CASE DOCKETED TO EXAMINER IN GAU			
8	04/02/2001	PRELIMINARY AMENDMENT			
7	12/19/2000	PRELIMINARY AMENDMENT			
6	01/08/2001	CASE DOCKETED TO EXAMINER IN GAU			
5	01/02/2001	APPLICATION DISPATCHED FROM OIPE			
4	01/02/2001	APPLICATION IS NOW COMPLETE			
3	10/03/2000	CORRESPONDENCE ADDRESS CHANGE			
2	08/04/2000	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/18/2000	INITIAL EXAM TEAM NN			

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## EXPLANATION OF PTA CALCULATION

## EXPLANATION OF PTE CALCULATION

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